

REMARKS

1. In response to paragraph 1 of the Office Action, Applicant acknowledges the Office's communication is responsive to Amendment filed June 6, 2007.
2. In response to paragraph 2 of the Office Action, Applicant acknowledges claims 1-20 are pending, claims 1, 9 and 17 are the independent claims, and the Office Action is final.
3. In response to paragraph 3 of the Office Action, Applicant amended its independent claims 1, 9 and 17 to include "the call to the code" as Examiner Nguyen advised.
4. In response to paragraphs 4, 5 and 8 of the Office Action, Applicant acknowledges the Examiner's citation to Erev *et al.* (U.S. Publication No. 2003/0084106) as forming the basis for the Office Action's rejection of Applicant's claims 1, 2, 4-13, 15-18, and 20 under 35 U.S.C. § 102 (e). Applicant objects with traverse to Erev anticipating Applicant's claims 1, 2, 4-13, 15-18, and 20. In addition, Applicant acknowledges and responds to the Office's reply at paragraph 8 of the Office Action.

Herein, Applicant presents amended claims for entry that do not add new matter.¹ Specifically, Applicant's independent claim 1, and by analogy independent claims 9 and 17, are amended to further clarify that the cited art does not anticipate Applicant's claims. In addition, new independent device claim 21 has also been added for entry.

For a claim to be anticipated, Erev must describe each element and limitation of that claim.² Further, Erev "must also enable one of skill in the art to make and use the claimed invention."³ Below, Applicant shows that Applicant's amended claim 1, and by analogy amended claims 9 and 17, are not anticipated by Erev as a matter of law.

¹ 37 C.F.R. § 1.121 (c), (f).

² *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

³ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985).

Erev fails to describe Applicant's "generating" claim element and its many limitations in amended claim 1, *i.e.*, "generating the call to the code, wherein the code downloads the email attachment upon activation of the call by the recipient of the stripped email, wherein the code responds to user-defined rules configured for instructing an identity and a location of the email attachment for the recipient, wherein the identity and the location may differ for other recipients."⁴ Applicant's claimed invention generates a call to code when a recipient activates a call associated with a stripped email. That call generates code that downloads an email attachment for a recipient based on user-defined rules configured for instructing the identity and the location of the email attachment for the particular recipient. Stated another way, Applicant's claimed call to code is *always* a dynamic link. By comparison, Erev does claim or describe, by any stretch, a call to code that is always a dynamic link. In fact, Erev teaches just the opposite: a static link that is not always dynamic, and a pointer accessible through URL, which is not code – markedly different from Applicant's claimed invention. For example, Applicant's claimed invention may have the call to code download an email attachment with an identity, *i.e.*, version, and location, *i.e.*, in Thailand, for a particular recipient of an email. Applicant's claimed invention may also have the call to code download an email attachment with the same or different identity and the same or different location for another recipient of the same email. By contrast, Erev's URL always points to the same email attachment for all recipients of an email. As a matter of law, therefore, Erev fails to anticipate Applicant's amended claim 1 since it fails to disclose any enabling disclosure of Applicant's "generating the call to the code" element and its many limitations found in three "wherein" clauses. Accordingly, since amended claim 1 is not anticipated by Erev under § 102 (e), then any and all claims depending therefrom are also not anticipated.⁵ And, by analogy, amended claims 9 and 17 are neither anticipated by Erev under § 102 (e), and nor are any of the claims depending therefrom.⁶

5. In response to paragraphs 6 and 7 of the Office Action, Applicant acknowledges the Examiner's citation to Erev *et al.* (U.S. Publication No. 2003/0084106) in view of Hanna *et*.

⁴ See, *e.g.* Applicant's Specification ¶¶ 8, 25, 26, 31-33, 40, 46, 56.

⁵ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

⁶ *Id.*

al. (U.S. Pat. No. 7,054,905) as forming the basis for the Office Action's rejection of Applicant's claims 3, 14 and 19 under 35 U.S.C. § 103 (a). Applicant objects with traverse to Erev in view of Hanna rendering obvious Applicant's claims 3, 14 and 19.

As shown above, Applicant's amended, independent claims 1, 9 or 17 are not anticipated by Erev. Furthermore, since the Office admits that Erev does not render any of Applicant's independent claims as obvious, then none of Applicant's claims are obvious under Erev in view of Hanna.⁷ Accordingly, Applicant respectfully requests withdraw of all obviousness rejections as a matter of law.

⁷ *Id.*

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully submits that the instant application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney using the contact information found in his signature block below.

Besides the RCE and the one additional independent claim fees, no other fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

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